

Notice of Allowability

Application No.

09/786,817

Examiner

Michael C. Wilson

Applicant(s)

SMITH ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11-18-04.
2. ☒ The allowed claim(s) is/are 34, 36 and 37.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

MICHAEL WILSON
PRIMARY EXAMINER

REASONS FOR ALLOWANCE

The amendment filed 11-18-04 has been entered.

The following is an examiner's statement of reasons for allowance:

Claims 12, 14, 16, 17, 25, 31-33, 38, 39, 43, 44, 49 and 50 have been canceled.

Claims 34, 36 and 37 remain pending and under consideration in the instant application.

Priority

A certified copy of 9819912.8 filed in the United Kingdom on 9-11-98 was filed 3-9-01 (see the letter sent by the patent office April 12, 2001, which states a copy of the international application was filed). The courtesy copy filed 2-13-04 of the certified copy of priority document GB9819912.8 has been entered.

Drawings

The application will be published without drawings. The drawings filed 3-13-04 and 10-21-04 have not been entered.

Claim Objections

The claim objections have been withdrawn in view of the amendment.

Claim Rejections - 35 USC § 112

The rejection of claims 12, 14, 16, 17, 25, 31-34, 36-39, 43, 44, 49 and 50 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement has been withdrawn because claims 12, 14, 16, 17, 25, 31-33, 38, 39, 43, 44, 49 and 50 have been canceled and in view of applicants arguments.

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The limitations of "dissociating the cells" and "maintaining the dissociated cells" in claims 34 and 37 has support on pg 27, lines 8-12, because PD098059 was added to ES cell media, which contained LIF (see pg 17, line 13).

The limitation of developing an embryo in vitro (claim 37) is in the preamble of original claim 37.

The rejection of claims 12, 14, 16, 17, 25, 31-34, 36-39, 43, 44, 49 and 50 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement has been withdrawn because claims 12, 14, 16, 17, 25, 31-33, 38, 39, 43, 44, 49 and 50 have been canceled and in view of applicants' arguments.

Applicants' argue the method claimed is not limited to the genetically modified ES cells described in the specification. Applicants' argument is persuasive. It would have been readily apparent to one of skill in the art that the method of culturing ES cells described in the specification could be used on any genetically altered ES cell or non-genetically altered ES cell. The claims do not require one of skill to know how to genetically alter the ES cells as described in the specification; therefore, the rejection regarding how to make the genetically altered ES cells described in the specification is improper because any genetically altered or non-genetically altered ES cell known in the art at the time of filing could be used in the claimed method.

The rejection of claims 12, 14, 16, 17, 25, 31-34, 36-39, 43, 44, 49 and 50 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out

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and distinctly claim the subject matter which applicant regards as the invention has been withdrawn because claims 12, 14, 16, 17, 25, 31-33, 38, 39, 43, 44, 49 and 50 have been canceled and because claims 34, 36 and 37 as amended are clear.

In particular, claims 34 clearly set forth that the ES cells are cultured in the presence of LIF and PD098059, and claims 34 clearly set forth that the ES cells are cultured in the presence of PD098059.

Claim Rejections - 35 USC § 102

The rejection of claims 12, 14, 16, 17, 25, 31-33, 43, 44 and 50 under 35 U.S.C. 102(a) as being anticipated by Niwa of record (July 1, 1998, Genes & Development, Vol. 12, pg 2048-2060) has been withdrawn because the claims have been canceled.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Wilson who can normally be reached at the office on Monday, Tuesday, Thursday and Friday from 9:30 am to 6:00 pm at 571-272-0738.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now

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contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on 571-272-0804.

The official fax number for this Group is (703) 872-9306.

Michael C. Wilson

A handwritten signature in black ink, consisting of a series of vertical, wavy lines followed by a horizontal stroke.

MICHAEL WILSON
PRIMARY EXAMINER